

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-8, 10-12 and 15 are rejected under 35 USC 102(e) over the U.S. patent to Long.

Claims 1-3, 5-12 and 15 are rejected under 35 USC 102(b) over the EP reference '761.

Claim 16 is rejected under 35 USC 103 over the U.S. patent to Long in view of the reference GB '440.

Also, Claim 4 is rejected under 35 USC 112.

After carefully considering the Examiner's grounds for rejection of the claims, applicants amended the claims so as to more clearly define the present invention and to distinguish it from the prior art.

The new features of amended Claim 1 are illustrated in Figures 2 and 5(b) and disclosed on page 9, line 24 to page 10, line 4 of the specification.

The new features of the amended Claim 4 can be seen for example in Figures 6(a) and 6(b) of the specification.

The new features of the amended Claim 15 are disclosed in the previously presented Claim 6 and can be found on page 11, lines 22-23.

Turning now to the Examiner's grounds for rejection of the claims over the art, and in particular the U.S. patent to Long et al, it is respectfully submitted that Long et al (US 7,313,838) discloses a hand-guided sander (10) which comprises a housing (12), a sanding plate (18) which is essentially delta-shaped, a sanding drive (30, 32, 34, 36, 37 and 38) for driving the sanding plate (18) and a rechargeable battery unit (40). The housing (12) has a size which is essentially limited to that of a base of the sanding plate (18). Moreover, the housing (12) is equipped to accommodate the rechargeable battery unit (40). The sanding plate (18) of the hand-guided sander (10) has a symmetry axis which extends from a tip of the sanding plate (18) through a center mass of the hand-guided sander to a blunt end of the sanding plate (18). On the symmetry axis of the sanding plate (18), a support point of the sanding plate (18) for the sanding drive (30, 32, 34, 36, 37 and 38) is situated (see Long et al, col. 3, line 43 to col. 5, line 58 and figures 3 and 6).

Long et al does not specify the precise arrangement of the support point on the symmetry axis of the sanding plate (18). Long et al therefore lacks the feature that the support point is located between the center of mass and the blunt end of the sanding plate (18). It is therefore respectfully submitted that the new features of the present invention defined in Claim 1 are not disclosed in the patent to Long et al.

The EP document (EP 0 232 761 B) discloses a hand-guided sander which comprises a housing (2) that is equipped to accommodate a rechargeable battery unit (16). Moreover, the hand-guided sander comprises a sanding plate (8) which has a support point for a sanding drive unit (3). The EP document lacks the feature that the sanding plate (8) is delta-shaped. Moreover, the EP document lacks the feature that the support point is located between the center of mass and a blunt end of the sanding plate (8). The new features of the present invention as defined in Claim 1 are also not disclosed in this reference.

The Examiner rejected the original claims over the patent to Long as being anticipated. In connection with this, it is believed to advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Long does not disclose each and every element of the present invention as now defined in amended Claim 1. Therefore, it is respectfully submitted that the anticipation rejection of the original claims over the patent to Long should be considered as not tenable and should be withdrawn.

The GB document (GB 2 380 440) discloses a hand-guided sander (1) which comprises a housing and a sanding plate (29) which has a support point for a sanding drive unit. The GB document lacks the feature that the sanding plate (29) is delta-shaped. Moreover, the GB document lacks the feature that the support point is located between the center of mass and a blunt end of the sanding plate (29). Therefore, the amended Claim 1 is new over the GB document.

It is respectfully submitted that the above mentioned reference applied by the Examiner against the claims also does not provide any hint, suggestion or motivation for the new features of the present invention as defined in Claim 1.

The aim of the object of the present patent application is to provide a compact hand-guided sander through which advantageous access to corners and edges as well as a very good sanding pattern, can be achieved.

This aim is achieved with the features of the amended Claim 1, wherein the support point of the delta-shaped sanding plate is located between the center of mass and the blunt end of the sanding plate (see specification, page 10, lines 3-18). The delta-shaped design of the sanding plate, in combination with the limited extension of the housing, enables an advantageous access to corners and edges of the hand-guided sander. Moreover, the arrangement of the support point between the center of mass and the blunt end of the sanding plate has the advantage that each point on the sanding plate or each sanding granule of a piece of sandpaper attached to the sanding plate, describes its own individual curved path. Hereby, the movement of the sanding granules are largely elliptical, wherein the size of the ellipses increases with the distance from the support point (see specification, page 10, lines 4 to 8).

A person skilled in the art would not have been able to find any hints in Long et al, but rather in the EP document which would have led him to arrange a support point on a symmetry axis between a center of mass and a blunt end of a sanding plate.

Therefore, the amended Claim 1 should also be considered as unobvious over Long et al., the EP document and the GB document or a combination of the cited references.

In order to arrive at the present invention from the references over their combination, the references have to be fundamentally modified, and in particular by including into them the new features of the present invention which are now defined in amended Claim 1 and were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is therefore believed that Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

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